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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,131	06/24/2003	Bohumil Pergl	J400-003 CIP	1600
21706	7590	01/12/2005	EXAMINER	
NOTARO AND MICHALOS 100 DUTCH HILL ROAD SUITE 110 ORANGEBURG, NY 10962-2100			CHEN, TIANJIE	
			ART UNIT	PAPER NUMBER
			2652	

DATE MAILED: 01/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/602,131

Applicant(s)

PERGL, BOHUMIL

Examiner

Tianjie Chen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/805,345.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

Non-Final Rejection

Priority

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 09/805,345, filed on 03/13/2001.

Specification

2. The disclosure is objected to because of the following informalities:
 - Applicant declares Fig. 1 shows "a conventional compact disc" in [0025] and all the following figures are sectional views of Fig. 1. Therefore, the following figures should be considered as the sectional views of a conventional compact disc. The metes and bounds of this invention are missing.Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Otani et al (JP 11-238262) in view of Inaba (JP 2000-40263) and Schroeder et al (US 5,791,990).

Claim 1, Otani et al shows a compact disc of circular shape in Figs. 1-4 including: disc body having a central annular portion 13 and recording portion 14; recording layer 21; a basic cover paint (colored adhesive, see Abstract) applied to the

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film 41, which covers the annular portion 13 (Fig. 4); at least one defined area with a border and central portion situated in the annular recording portion containing a hidden printing (ABCDE in Fig. 2).

Otani et al does not show a reflective layer provided on the recording portion of the disc body and covered by protective coating.

Inaba shows a compact disk wherein a reflective layer 5 provided on the recording portion of the disc body and covered by protective coating 3 (Fig. 3; and see Abstract).

It would have been obvious at the time the invention was made to one of ordinary skill in the art to expect a reflection layer and protective coating taught by Inaba into Otani et al's device. The rationale is as follows: Otani et al teaches that the reflection factor is to be measured for the compact disc ([0002], line 4). Therefore, a reflection layer is a must, but Otani et al fails to show the detail of the structure for reflecting. Inaba teaches a structure for reflecting the light for measurement of the reflection factor and this structure is notorious in the art. One of ordinary skill in the art would have been motivated to expect the existence of the reflection layer and the protective layer in Otani et al's device.

Otani further fails to show a scratch-off paint coating covering the defined area.

Schroeder et al shows a scratch-off paint coating to be used for compact discs (column 3, lines 24-25).

It would have been obvious at the time the invention was made to one of ordinary skill in the art to add the scratch-off paint coating onto Otani et al's device. The rationale is as follows: Schroeder teaches that the scratch-off paint coating can be used for a compact disc (Column 3, lines 24-25) for activating a computer program

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(Column 4, lines 44-46). One of ordinary skill in the art would have been motivated to add the scratch-off paint coating on Otani et al's disc to active a computer program. This scratch-off coating would cover the defined area.

Claim 2, Inaba shows that the defined area printing is separated from the scratch-off paint by a translucent interlayer coating 41 for protecting the hidden printing when applying and removing the scratch-off paint.

Claim 3, since the defined area is reasonably expected to be in a dimension of 4 mm or more. Therefore, the interlayer coating overlaps the boarder portion of the defined area by at least 2 mm.

Claim 4, Otani et al shows the thickness of the interlayer coating is in the range from 40 to 50 microns ([0013]).

Claim 5, Schroeder et al shows the scratch-off paint coating can bear any kind of information, which would include guidance printing for guiding the user to active the computer program.

Claims 6 and 7, the above described Otani et al, Inaba, and Schroeder et al's device includes a compact disc of circular and non-circular shape including: a disc body having central annular portion and a recording portion; a recording and reflective layer provided on the recording portion of the disc body and covered protective coating; a basic cover paint applied the annular portion; at least one defined area with border and central portion situated in the annular recording portion and containing a hidden printing; a translucent interlayer coating covering the defined area; and a scratch-off paint coating applied to the interlayer coating. And the translucent interlayer coating is from 40 to 50 microns in thickness and overlaps the boarder portion of the defined area by at least 2 mm.

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Conclusion

4. The prior art made of record in nPTO-892 Form and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tania Chen whose telephone number is (703) 305-7499. The examiner can normally be reached on 8:00-4:30, Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa Nguyen can be reached on (703) 305-9687. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


TIANJIE CHEN
PRIMARY EXAMINER